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EXAMINER

YIMAM, HARUN M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN M. GOLDSCHMIDT IKI, CHRISTOPHER D. WILLIAMS,
ANTHONY A. SHAH-NAZAROFF, and DAVID N. HACKSON

Appeal 2007-3996
Application 09/916,704
Technology Center 2600

Decided: May 23, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of
claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a graphical user interface (GUI) in which video data of a first entertainment selection is displayed in a first window, and entertainment system data corresponding to the first entertainment selection is displayed in a first area of the first window. Further, video data of a second entertainment selection is displayed in a second window with entertainment system data corresponding to the second entertainment selection being displayed in a second area of the second window. Upon selection of a window by a user, entertainment system data regarding the entertainment selection corresponding to the selected window is displayed. (Specification 4).

Claim 1 is illustrative of the invention and reads as follows:

1. A method for presenting entertainment selections, comprising:
displaying video data of a first entertainment selection on a first window;
displaying video data of a second entertainment selection on a second window;
and
displaying entertainment system data regarding the entertainment selection corresponding to the respective window upon selection by a user of the respective window.

The Examiner relies on the following prior art references to show unpatentability:

Matthews, III (Matthews)	US 5,815,145	Sep. 29, 1998
Broadwin	US 5,903,816	May 11, 1999
		(filed Jul. 1, 1996)

Claims 1-7 and 9-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Matthews.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Matthews in view of Broadwin

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C. § 102(e), does Matthews have a disclosure which anticipates the invention set forth in claim 1-7 and 9-20?
- (ii) Under 35 U.S.C. § 103(a), with respect to appealed claim 8, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Matthews with Broadwin to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of

ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(e) REJECTION

Claims 1, 4-9, 11, 13, 14, 16, 17, and 19

With respect to the 35 U.S.C. § 102(e) rejection of independent claims 1, 11, and 17 based on the teachings of Matthews, the Examiner indicates (Ans. 4, 7, and 9) how the various limitations are read on the disclosure of Matthews. In particular, the Examiner directs attention to the illustration in Figures 3 and 4 of Matthews, as well as the accompanying description at column 4, line 35 through column 5, line 45 of Matthews.

Appellants’ arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Matthews so as to establish a prima facie case of anticipation. Appellants initially contend (App. Br. 8-9; Reply Br. 3-4) that, in contrast to the requirements of appealed independent claims 1, 11, and 17, Matthews does not provide for displaying entertainment system data upon selection of a window by a user.

We find no error, however, Appellants’ arguments to the contrary notwithstanding, in the Examiner’s stated position (Ans. 11-13) that the display of moving video images, which occurs in Matthews upon user selection of a displayed window, corresponds to the claimed entertainment system data. It is noteworthy that Matthews suggests (col. 5, ll. 30-35) that a

“digitized video segment” related to a selected program may be displayed in the selected window on the tiled window display.

We further find to be without merit Appellants’ argument (Reply Br. 3) that the Examiner’s attempt to establish correspondence of the disclosure of Matthews with the limitations in the appealed independent claims 1, 11, and 17 must fail because the still images displayed in Matthews’ non-selected tiled windows are not “video” data as claimed. Indeed, Appellants’ own disclosure (Specification, paragraph 0041) recognizes that a still image of a broadcast program, such as displayed in the non-selected tiled windows in Matthews, is considered a “video” image.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Matthews, the Examiner’s 35 U.S.C. § 102(e) rejection of independent claims 1, 11, and 17, as well as dependent claims 4-9, 13, 14, 16, and 19, not separately argued by Appellants, is sustained.

Dependent claims 2, 3, 12, and 18

We also sustain the Examiner’s anticipation rejection of dependent claims 2, 3, 12, and 18 based on Matthews. Appellants contend (App. Br. 9; Reply Br. 4) that, contrary to what is presently claimed, Matthews, while disclosing display areas of each tiled window, has no disclosure of independently selecting a particular area of a tiled window.

We find Appellants’ arguments to be not commensurate with the scope of dependent claims 2, 3, 12, and 18. We find no disclosure in Appellants’ Specification that would support the claim interpretation urged by Appellants in the Briefs, i.e., that particular areas of each display window can be independently selected to display the content of that window area.

We simply find no error in the Examiner's finding (Ans. 5 and 13) that the ability of the cursor in Matthews to move around the tiled windows without limitation enables a particular tiled window to be selected as claimed. We agree with the Examiner that the ordinarily skilled artisan would recognize and appreciate from the disclosure of Matthews that a particular tiled window can be selected by a user whenever the cursor is located in that window including the areas of the window that depict channel numbers and channel logos.

Dependent claims 10, 15, and 20

The Examiner's 35 U.S.C. § 102(e) rejection, based on Matthews, of dependent claims 10, 15, and 20, directed to entertainment selection based on a user's preferred trait is also sustained. Appellants' argument in response (Reply Br. 5) contends that, under the Examiner's analysis, the preferred trait in Matthews is "list first" and, accordingly, there can be only one selection with this trait in contrast to the appealed claim language which requires two entertainment selections.

We do not find this argument to be persuasive. Contrary to Appellants' assertions, we do not find the "trait" in Matthews to be "list first" but, rather, as set forth by the Examiner, Matthews' trait is "most frequently accessed channels." We agree with the Examiner (Ans. 7) that the grouping together in Matthews of "most frequently accessed channels" is a preferred user's trait which is related to an entertainment selection as claimed. As explained by the Examiner (Ans. 14), the use of the "most frequently accessed channel" feature results in a modified channel

arrangement in the database of Matthews enabling multiple entertainment selections from this modified channel arrangement.

35 U.S.C. § 103(a) REJECTION

Dependent claim 8

We also sustain the Examiner's obviousness rejection of dependent claim 8 in which the Broadwin reference has been added to Matthews to address the full-screen display feature of the claim. Appellants (App. Br. 6) have made no separate arguments for patentability of claim 8 but, instead, have relied on arguments with respect to Matthews made against the rejection of claims 1-7 and 9-20, which arguments we found to be unpersuasive as discussed *supra*.

CONCLUSION

In summary, we have sustained the Examiner's rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

gvw

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